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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,646	07/02/2003	Burns Phillips	077119-0026	4622
1923 7590 05/21/2009 MCDERMOTT, WILL & EMERY LLP Attn: IP Department 227 WEST MONROE STREET SUITE 4400 CHICAGO, IL 60606-5096			EXAMINER MERENE, JAN CHRISTOP L	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/21/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,646

Applicant(s)

PHILLIPS ET AL.

Examiner

JAN CHRISTOPHER MERENE

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24, 27, 28, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 31 is/are allowed.
- 6) ☒ Claim(s) 17-24, 27-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 17-19, 22-24, 27-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bookwalter et al US 5,424,724 in view of Kubicki et al US 5,171,927.

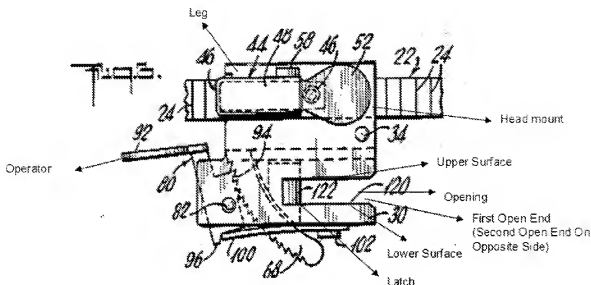
Regarding **Claims 17-19, 22-24, 27-28**, Bookwalter discloses a surgical retractor having at least one arm operably connected to a rack, the surgical retractor comprising:

a clamp having an opening for receiving a portion of the arm, the opening defined by an upper surface and a lower surface defining a slot, the opening having an axis that extends between the upper surface and the lower surface of the opening, and the axis further extending from a first open end of the opening to a second open end of the opening;

a latch connected to the clamp for selectively retaining the clamp at a selected position on the arm, the latch engages the tooth of the arm (see Figs below and see Col 4 lines 40-45);

an angularly adjustable leg pivotally coupled to the clamp about a pivot axis that is parallel to the axis of the opening, wherein the leg pivots relative to the upper surface of the opening and the lower surface of the opening, the leg having a retractor blade connector head mount for receiving a connector head of a retractor blade, where the leg extends cantileveredly away from the clamp (see Fig below and Fig 2); and

an operator connected to the leg to adjust the angular position of the leg with respect to the clamp, wherein the operator adapted for rotation to allow incremental movement of the leg relative to the clamp, where the operator moves the leg relative to the clamp (as seen in Fig below and see Col 4 lines 15-25, where the operator pivots the arm, wherein the opening has a first open end and a second open end with an axis, where the pivot axis is parallel to the axis).



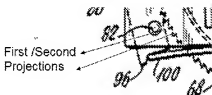
However, Bookwalter discloses a ratchet system to adjust the leg (see Col 4 lines 15-25 and Fig above) but does not specifically disclose the operator comprises a threaded shaft.

However, Kubicki teaches a similar ratcheting mechanism (as seen in Fig 2) with a ratch (#26) and an operator with a threaded shaft (#28), where rotation of the operator pivotally rotates the ratchet (#26, see Col 4 lines 38-45, 55-60), where it includes a quick release button (#47) to disengage the ratcheting mechanism (see Col 11 lines 13-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the operator of Bookwalter to include the threaded shaft (#28) of Kubicki as taught above because it is a simple substitution one known type of ratcheting mechanism for another to obtain predictable results of pivotally rotating a

ratchet arm, wherein one can rotate the shaft without moving it longitudinally (see Col 4 lines 38-45, 55-60).

With regards to Claim 23, see Fig above where Bookwalter teaches a first and second projection forming a U Shape.



5. **Claims 19, 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bookwalter et al US 5,424,724 and Kubicki et al US 5,171,927 as applied to claim 17 above, and further in view of Gauthier US ,3965,890.

Bookwalter and Kubicki disclose the claimed invention as discusses above, but does not specifically disclose a latch pivotally connected to the clamp, where it has a release button to disengage the latch from the arm.

However, Gauthier teaches a clamp with a latch (#11) and release button to release the clamp from the arm (see Col 4 lines 28-32).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the latch of Bookwalter with that of Gauthier as taught above because the latch and quick release button allows one to position the clamp easily along the rack (see Col 4 lines 25-36).

6. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Bookwalter et al US 5,424,724, Kubicki et al US 5,171,927, and Gauthier US ,3965,890 as applied to claim 19 above, and further in view of Dobrovolny 2002/0177753.

Bookwalter, Kubici, and Gauthier disclose the claimed invention as discussed above but does not specifically disclose a spring.

However, Dobrovolny teaches the use of a spring (#104) to bias a latch (see paragraph 27)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the latch of Bookwalter, Kubici, and Gauthier to include a spring because a spring applies a known technique to a known device ready for improvement to yield predictable results of biasing a latch/lever/button (see paragraph 27).

Allowable Subject Matter

7. Claims 30-31 allowed.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and relied upon is considered pertinent to the applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAN CHRISTOPHER MERENE whose telephone number is (571)270-5032. The examiner can normally be reached on 8 am - 6pm Mon-Thurs, alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jan Christopher Merene/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733